REMARKS/ARGUMENTS

I. Status of Claims

Claims 1-18 are pending with claims 1, 8, 13, 14, and 15 being independent.

II. Provisional Double Patenting Rejection

Claims 15 and 16 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/658,208, now U.S. Pat. No. 7,623,186.

Applicants hereby provide a terminal disclaimer, as attached to this paper. Accordingly, the Examiner is kindly requested to withdraw the nonstatutory obviousness-type double patenting rejection.

III. Rejections under 35 U.S.C. §103(a)

Claims 1 and 2

Claims 1 and 2 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jang (U.S. Patent No. 2,347,588 – hereinafter Jang) in view of Yamaguchi (U.S. Pub. No. 2007/0206518 – hereinafter Yamaguchi), Kida et al. (U.S. Patent No. 6,335,728 - hereinafter Kida), Hassell et al. (U.S. Pub. No. 2004/0107439 – hereinafter Hassell) and Kwon et al. (U.S. Patent No. 7,057,621 – hereinafter Kwon). Applicants respectfully traverse this rejection.

Claim 1 recites a display apparatus for a mobile terminal for displaying a television video signal in the mobile terminal, comprising, inter alia, video processing means, wherein said video processing means further comprises *a format scaler for scaling a size of said video data to a predetermined frame size on the basis of said synchronous signals from said decode (for decoding the television signal).*

In the previous non-final Office Action mailed on November 5, 2009, upon acknowledging that none of Jang, Yamguchi, Kida and Hassell discloses the format

scaler as claimed, the Examiner relies on Kwon as allegedly disclosing the format scaler as claimed, particularly citing the vertical expansion unit 28 of Fig. 2 of Kwon.

Responding to this contention, Applicants point out, as in the Response filed February 4, 2010 (hereinafter "the February Response"), that Kwon does not teach or suggest the format scaler as claimed, since the vertical expansion unit 28 of Kwon does not receive any synchronous signals (much less synchronous signals from a decoder for decoding a television signal) as input.

In the "Response to Arguments" section of the final Office Action, responding to above-noted Applicants' argument, the Examiner cites Jang, particularly the sync signal disclosed on page 11, lines 12-16 and Fig. 1 of Jang, alleging as follows:

> "While the synchronization signal of Jang is [sic] used to superimpose messages of the television signal, *it is of common knowledge in the art the use the sync signal to control a format scaler as recited by Kwon.*" (emphasis added).

Hence, the Examiner does not really disagree with Applicants in terms of Kwon's noted deficiency, but rather changes the theory of the rejection from solely relying on Kwon to using both Jang and Kwon.

However, the Examiner's citation of Jang in connection with Jang's synchronization signal of Jang being used to superimpose characters *had already been* addressed in the previous Response filed on July 27, 2009 (hereinafter "July Response"). More specifically, with respect to Jang's sync signal, in the July Response, Applicants point out that (1) Jang only discloses that a horizontal synchronizing signal is used by the character imposing generator 28 to derive a count value upon which the generation of a character imposing signal is based, and (2) nowhere does Jang teach or suggest that synchronous signals can be used as the basis for scaling video data to predetermined size, as is the case for the format scaler as claimed.

Hence, the Examiner's above-quoted assertion that "[based on Jang's teaching,] *it is of common knowledge in the art the use the sync signal to control a format scaler as recited by Kwon*" is made without any factual basis, since Jang clearly does not disclose, teach, or suggest *using the sync signal to control a format scaler.* Accordingly, the Examiner's above-noted "common knowledge" assertion is clearly improper.

Further, if the Examiner is taking Official Notice with respect to this "common knowledge" assertion, Applicants challenges the Examiner's use of Official Notice. Per MPEP 2144.03, while "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113 as was done here. Official Notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known, which is clearly not the case here. The Examiner must therefore provide documentary evidence in the next Office action if the Official Notice is to be maintained. See 37 CFR 1.104(c)(2). Therefore, Applicants hereby traverse the Examiner's assertion of Official Notice for these reason.

Accordingly, because the Examiner's Official Notice is improperly taken, the Examiner's new arguments, which is premised upon the validity of the Examiner's Official Notice, are incorrect.

Accordingly, Applicants respectfully submit that, since neither Jang nor Kwon discloses or suggests the claimed feature of *scaling a size of said video data to a predetermined frame size on the basis of synchronous signals*, the proposed combination of Jang and Kwon also fails to disclose or suggest the claimed feature.

In addition, in support of the Examiner's new theory based on the combination of Jang and Kwon, the Examiner asserts that "[T]he test for combining references in

what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art; since, *references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures.*" (See page 2 of the final Office Action, emphasis added). Applicants respectfully disagree.

First, the Examiner does not provide any legal authority supporting the Examiner's assertion that "*references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures.*"

Second, it is long settled that, only after the Examiner has already established a prima facie case where each and every limitation of a claim has been found in cited prior references, the Examiner may then reject the claim under obviousness based on a combination of cited prior art references. See Ex parte Kumagai, 9 U.S.P.Q.2d. 1642, 1646 (B.P.A.I. 1988) (holding that a rejection under obviousness based on a combination of cited prior art references can only be applied when each "building block" of the rejected invention was already known in the prior art since an obvious system cannot be built with *empty* 'blocks' devoid of any means already known in the prior art). In other words, contrary to the Examiner's assertion, only when the cited prior art references have *disclosure* of each and every limitation of a claim (albeit not in the same reference), may the Examiner begin to establish a prima facie case of obviousness.

Accordingly, for at least the foregoing reasons, the Examiner's new theory of rejection based on the combination of Jang and Kwon is also incorrect.

Further, in support of the rejection, the Examiner additionally cites Park (U.S. Pat. Pub. No. 2004/0100578), Park et al. (U.S. Pat. Pub. No. 2004/0041850) and Patel (U.S. Pat. No. 6,396,542), alleging that these references "clearly show examples and teachings of a decoded sync signal used to control a television picture scaler".

However, with respect to Park et al. and Patel, the Examiner does not point to any disclosure to substantiate the Examiner's allegation on Park et al. and Patel. Therefore, the Examiner's allegation on Park et al. and Patel is incorrect.

In particular, the cited Park et al. does not qualify as a prior art reference under 35 U.S.C. 102(e), since the March 6, 2003 filing date of Park et al. is later than the September 17, 2002 priority date of the present application, which had been perfected under MPEP §201.15 and 37 C.F.R. §1.55 by Applicants' January 30, 2008 submission of a verified translation of the priority document Korean Patent Application No. 2002-56639. Accordingly, Applicants respectfully submit that Park et al. is not available as a prior art reference, and thus should not be used in any future rejections.

With respect to Park, the Examiner points to scaler 46, control section 53 and sync separating section 51 of Fig. 3 as well as paragraphs [0002] and [0027] of Park, alleging that Park discloses control section 53 as controlling scaler 46 to adjust the size of the television picture according to the horizontal/vertical sync signals separated by the sync separating section 51. Applicants respectfully disagree.

More specifically, nowhere does Fig. 3 or paragraphs [0002] and [0027] of Park disclose that control section 53 controls scaler 46 to adjust the size of the television picture according to the horizontal/vertical sync signals separated by the sync separating section 51. Rather, Fig. 3 and paragraph [0027] of Park merely disclose that control section 53 is for controlling the region extracting section/scaler 46 to extract the video signal of the whole picture and to adjust a position and a size of the sub picture, and paragraph [0002] is irrelevant to control section 53. In particular, there is no disclosure or suggestion that the scaling is according to the horizontal/vertical sync signals separated by the sync separating section 51. Accordingly, the Examiner's allegation on Park is also incorrect.

To summarize, none of Jang, Kwon, Park, Park et al. and Patel has any relevance to the claimed feature of *scaling a size of said video data to a predetermined frame size on the basis of synchronous signals*.

Therefore, the Examiner's new theory of rejection based on the combination of Jang and Kwon as well as the Examiner's ground of rejection based on Park, Park et al. and Patel are incorrect. Accordingly, since Yamguchi, Kida and Hassell do not cure the above-noted deficiency of Jang, Kwon, Park, Park et al. and Patel, claim 1 should be allowable over Jang, Kwon, Park, Park et al., Patel,Yamguchi, Kida and Hassell. The rejection of claim 1 should therefore be withdrawn.

The rejection of claim 2 should be withdrawn at least by virtue of its dependency from claim 1.

Claims 3-18

Claims 8-9, 13, 15, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jang in view of Yamaguchi, Kida, Hassell, Kwon and further in view of Kim (KR 2001-059645 – hereinafter Kim). Claims 3 and 5-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jang in view of Yamaguchi, Kida, Hassell, Kwon and further in view of Barile (U.S. Pub. No. 2002/0093531 – hereinafter Barile). Claims 10-12, 14, and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jang in view of Yamaguchi, Kida, Hassell, Kwon, Kim and further in view of Barile. Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Jang, Yamaguchi, Kida, Hassell, Kwon, and Barile and further in view of Ng (U.S. Patent No. 6,681,285 – hereinafter Ng). Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Jang, Yamaguchi, Kida, Hassell, Kwon and Kim, and further in view of Yui (U.S. Patent No. 6,885,406 – hereinafter Yui).

Claims 8, 13, 14 and 15 contain subject matter related to that of claim 1, particularly with respect to the above-noted scaling feature. Accordingly, for at least the same reasons stated above in connection with claim 1, claims 8, 13, 14 and 15

should also be distinguishable over Jang, Yamaguchi, Kida, Hassell and Kwon. On the other hand, the cited secondary references Kim and Barile do not cure the above-noted deficiency of Jang, Yamaguchi, Kida, Hassell and Kwon. Accordingly, the rejections of claims 8, 13, 14 and 15 should be withdrawn.

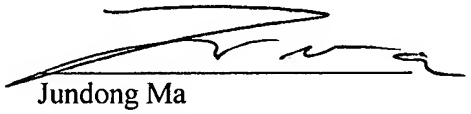
The rejections of claims 3-7, 9-12, and 16-18 should be withdrawn at least by virtue of their dependency from claims 8, 13, 14 and 15 respectively and the fact that the cited secondary references Ng and Yui do not cure the above-noted deficiency of Jang, Yamaguchi, Kida, Hassell, Kwon, Kim and Barile.

IV. Conclusion

In view of the above, it is believed that this application is in condition for allowance and notice to this effect is respectfully requested. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the telephone number indicated below.

Should **any/additional** fees be required, the Director is hereby authorized to charge the fees to Deposit Account No. 18-2220.

Respectfully submitted,



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